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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,374	12/15/2000	Masatoshi Arai	1359.1031	7612
21171	7590	01/22/2009		
STAAS & HALSEY LLP			EXAMINER	
SUITE 700			CAMPEN, KELLY SCAGGS	
1201 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/736,374	<b>Applicant(s)</b> ARAI ET AL.
	<b>Examiner</b> KELLY CAMPEN	<b>Art Unit</b> 3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 21 October 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.  
 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 October 2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

*The following is in response to the Amendments and arguments filed 10/21/2008. Claims 1-17 are pending, claims 16-17 have been withdrawn from consideration.*

***Drawings***

The drawings were received on 10/21/2008. These drawings are acceptable.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter is nonstatutory under 35 U.S.C. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in

the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components or statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-7, 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In view of the extensive indefinite concerns in the claims, the following prior art rejection has been made as best as the claims may be interpreted.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Giacalone, JR (US 2001/005200).

Specifically as to claim 1, Giacalone, Jr. discloses a digital contents advertisement display computer system using an auction, comprising: a contents distribution unit; a computer processor; and a computer readable medium storing at least one computer program controlling the computer processor to perform operations comprising: disclosing an outline of digital displayable contents to be distributed through a digital medium to audiences; allowing the

audiences, as sponsors, to bid for becoming an advertisement tenant to be displayed in the disclosed digital displayable contents when displaying the digital displayable contents; determining a winning sponsor for the advertisement tenant 'from among the bidding sponsors, according to a highest price bid by a sponsor; and updating the digital displayable contents to contain the advertisement tenant, according to requests from the winning sponsor, to complete the digital displayable contents and distributing the completed digital displayable contents via the contents distribution unit (see paragraphs [0009],[0019], [0041],[0048],[0053],figure 6).

Specifically as to claim 2, wherein the computer processor operations further comprise receiving an input from an audience and allowing the audience to influence a scenario process of the displayable contents (see paragraphs [0009],[0019],[0053],figure 6).

Specifically as to claims 3 and 4, wherein, in a case where an advertisement tenant is not determined in the determining of the winning sponsor the digital displayable contents is distributed using a default advertisement tenant in the digital displayable contents (see paragraphs [0009],[0019], [0041]).

Specifically as to claims 5-6, 11-12, wherein the computer processor operations further comprise controlling behavior of a character displayed on a screen in accordance with a bidding price by a sponsor, wherein the character behaves so that the audience pays more attention to the advertisement tenant for which the bidding price is higher (see paragraphs [0009], [0019]).

Specifically as to claims 7 and 8, wherein the computer processor operations further comprise recording an access log with respect to the character, and calculating a degree of attention to the advertisement tenant based on the access log recording, wherein advertising

effects can be measured based on the calculated degree of attention to the advertisement tenant (see paragraphs 0048], [0053], figure 6).

Specifically as to claims 9 and 10, wherein the computer processor operations further comprise changing a display of the advertisement tenant so that a degree of attention to the advertisement tenant in the contents is changed in accordance with a bidding price (see paragraphs [0009], [0019], [0041], [0048], [0053], figure 6).

Specifically as to claims 13 and 14, wherein if the digital displayable contents are redistributed, the advertisement tenant is auctioned again to the advertisement sponsors (inherent in advertising auctions, see in addition, paragraphs [0019]-[0053]).

Specifically as to claim 15, Miyashita discloses a computer-readable recording medium storing a program to be executed by a computer, for realizing a digital contents advertisement display system using an auction, the program controlling the computer to perform operations comprising: disclosing an outline of digital displayable contents to be distributed through a digital medium to audiences; allowing the audiences, as sponsors, to bid for becoming an advertisement tenant to be displayed in the disclosed digital displayable contents when displaying the digital displayable contents; determining a winning sponsor for the advertisement tenant from among bidding sponsors, according to a highest bid price by a sponsor; updating the digital displayable contents to contain the advertisement tenant, according to requests from the winning sponsor, to complete the digital displayable contents; and distributing the completed digital displayable contents (see above rejections for claims 1-14, in addition, see paragraphs [0009],[0019], [0041],[0048],[0053],figure 6).

***Examiner's Note***

Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Response to Arguments***

Based on the amendments filed 10/21/2008, the rejections under 35 USC 112 have been overcome.

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, filed 10/21/2008, with respect to the rejection(s) of claim(s) 1-15 under 35 USC 102 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly applied prior art.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Virine et al. disclose a system for providing demographically targeted information.

Goldhaber et al. disclose an attention brokerage for advertising. Matsukawa discloses advertisement distribution system. Kohda et al. disclose an advertising method and system for transaction an advertising frame and recording media. Sitnik discloses a digital television system which selects images for display in a video sequence .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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